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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,831	07/11/2001	Thomas J. Maginot	22220-06167	1578
758	7590	06/20/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,831

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108, 114, 140, 164, 165, 425-432 and 434-436 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 82 and 84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 70,71,73,75-78,80-82,84-86,88,90-96,98-102,104-109,117-119,121-140,142-144,146,148,151-153,155-157,159-162,164-166 and 425-436.

Continuation of Disposition of Claims: Claims rejected are 70, 71, 75-78, 80, 81, 85, 86, 90-96, 98-102, 104-107, 109, 117-119, 121-130-139, 142-144, 146, 148, 151-153, 155-157, 159-162, 166, and 433.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70, 71, 73, 75-78, 80-81, 85-86, 88, 90-96, 98-102, 104-107, 109, 117-119, 121-130, 132-139, 142-144, 146, 148, 151-153, 155-157, 159-162, 166, and 433 are rejected under 35 U.S.C. 102(e) as being anticipated by Piplani et al (US 5,489,295). Piplani anticipates the claim language where the locating step is not specifically disclosed thereby but inherent thereto because the graft is shown within the delivery device in Figures 9 to 19. The arms as claimed are met by the legs or struts of a Piplani as attachment means (126), the alignment step as claimed is performed in Figures 9 and 10 of Piplani where the graft is inserted into the hole (226). The attachment means self-expands so the claimed spring action and resiliency is met; see column 9, lines 7-12.

Regarding claim 71 and the other claims that set forth a flange portion, the claimed flange portion is made up coil springs (203) and/or hook-like elements (207) which constitute a projecting rim, edge, or collar to provide a place to attach other objects; i.e. a flange. Since the flange portion is made up of coil springs (203) and/or

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hook-like elements (207), it can be said that the arms (204) and (206) are within the flange portion. Even if one could argue that the arms (204) and (206) of Piplani are not within the coil springs (203), they are certainly with the hook-like elements (207), which is an alternative interpretation in the rejection. In other words, the flange portion is the collective total of the hook-like elements (207) and coil springs (203).

Regarding claim 117, the claimed arrangement occurs as the Piplani device is inserted through hole (227); see *supra*.

With regard to claim 118, during insertion of the graft, this configuration occurs and the first and second portions are connected to each other via the graft.

With regard to claim 123, the struts of Piplani extend laterally (i.e. from the side) from the inside surface of the graft.

Regarding claim 142, the order of the steps recited in the claim is not fixed such that the aligning step can be done before the advancing step.

Regarding claims 109 and 153, some additional advancing of the graft is not precluded by the present claim language such that the claimed method is reads on what is disclosed by Piplani.

Claim 77 is rejected under 35 U.S.C. 102(b) as being anticipated by Ersek (US 3,657,744). Ersek meets the claim language where the arms or struts as claimed are the metal members (22) of the sleeve (16) of Ersek; see Figure 1 and columns 2 and 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 75, 121-126, 128, 131, 132, and 134-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ersek (US 3,657,744) in view of Barone et al (US 5,360,443). Ersek meets the claim language where the arms (claims 75 and 78) as claimed are the metal members (22) of Ersek and the strut assembly as claimed (claim 121) is sleeve (16) of Ersek; see Figure 1 and columns 2 and 3. Ersek fails to disclose the use of a delivery device over the graft as claimed. However, Barone teaches that it was known to insert similar devices into arteries with a delivery device that encompasses the implant; see Figures 1 and 9. Therefore, it is the Examiner's position that it would have been considered prima facie obvious to insert the sleeve into the aorta of Ersek's invention so that less abrasion would occur to the inside of the aorta by the outside catheter or capsule as compared to the sleeve.

Allowable Subject Matter

Claims 82 and 84 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 108, 114, 140, 164, 165, 425-432, and 434-436 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed April 4, 2005 have been fully considered but they are not persuasive.

Applicant argues that various features of the claims are not disclosed by Piplani. However, upon review of Piplani (particularly Figures 9, 10, and 11), the Examiner concluded that all the claimed features are present therein such that the claim language is at least read of what is disclosed by Piplani. In particular, Applicant is requested to view Piplani with the understanding that the configurations claimed are met thereby even they are transitory configurations.

As with the other rejection, Applicant has a different view of Ersek that there is no aligning step. However, the aligning step is clearly shown in Figure 1. The insertion of the device into the arteriotomy of aorta (11) occurs after the step shown in Figure 1 as the device is connected to the aorta (11)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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